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09/775,425	02/01/2001	Lee A. Chase	LII153B US	7026
21133	7590	07/31/2007	EXAMINER	
VAN OPHEM & VANOPHEM, PC			STORMER, RUSSELL D	
REMY J VANOPHEM, PC			ART UNIT	
51543 VAN DYKE			PAPER NUMBER	
SHELBY TOWNSHIP, MI 48316-4447			3617	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/775,425	CHASE ET AL.	
Examiner	Art Unit		
Russell D. Stormer	3617		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 15 May 2007.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 29-66 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 29-66 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 16 January 2002 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_  
4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_\_  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the rim portion having a "flangeless rim flange" as set forth in claim 42 must be shown or the feature canceled from the claim.

In response, Applicants have argued that the drawings do show a "flangeless rim" as claimed, but Applicants own specification in paragraph 0060 states that the reference character 337 is a rim flange. A flangeless rim cannot have a rim flange. While Applicants arguments are not clearly understood, they attempt to find support in the provisional application 60/084378 where figure 2 is described as a "flangeless look." In no way is a "flangeless look" the same as a "flangeless rim," and the drawings may show a flangeless *look*, but a rim with no flange is not shown.

***No new matter should be entered.***

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The amendment filed March 27, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The "flangeless rim" or "flangeless wheel" as added to at least pages 11, 12, 17, and 26.

In response, Applicants have argued that the term "flangeless rim" finds support in the provisional application on page 6. It appears that Applicants are referring to the "euro styled flangeless look," a term which does not equate to a "flangeless rim."

Applicant is required to cancel the new matter in the reply to this Office Action.

4. The disclosure is objected to because of the following informalities:

The last sentence of paragraph 0014 is objected to because it is *not* logical to presume that the covers of the patents in question can extend radially beyond the peripheral edge of the wheel rim. This statement is not supported in the Todd and Hodges references referred to in that paragraph, and is actually nothing more than conjecture and Applicants' own opinion. This sentence must be deleted from the disclosure.

In response, Applicants have argued that some of the references discussed in the Background have covers that are wrapped around the rim flanges, such as those set forth in paragraphs 0015 and 0017. Paragraph 0015 is not the paragraph 0014 referred to in the objection. It appears that Applicants have not addressed the objection as presented in the office action. The covers in the Todd and Hodges patents do not extend over the edge of the rim flange, but this is not addressed. Applicants state that the objection is not understood, but this apparently the result of arguing what is discloses in paragraph 0015 and not paragraph 0014, on which the Objection is based.

Appropriate correction is required.

5. The disclosure is objected to because of the following informalities:

The use of the term "flangeless" to describe certain embodiments of the disclosed wheel rims is objected to as confusing and incorrect. The rims in figures 7-10 are described as being "flangeless" or "modified to be eliminated," but they actually do have rim flanges such as 337, 437, etc. The tire could not be retained on the rim without the flange. In these embodiments, the flange lip has been removed, or the flange has been modified to a different shape.

In response, Applicants referred to the Tire and Rim Association Standard Contour Nomenclature shown in figure 5 of the provisional application in an attempt to show that a flangeless wheel rim could retain a tire thereon. Applicants arguments do not address the objection made above, and are misleading and incorrect because the Tire and Rim Association Standard Contour Nomenclature shown in figure 5 does not make any reference to a flangeless rim, and does not suggest that a rim could retain a tire even if the rim had no flange.

Applicants further state the belief that the term flangeless is correct and that figures 7-10 of the instant application show flanges that "have been modified to be eliminated." This is not found persuasive because the description of figure 7 refers to a "rim flange 337." Figure 8 has a rim flange 437, and figure 9 has a flange lip 658 formed a truncated rim flange 137. See pages 23-25 of the substitutive specification filed March 27, 2006.

It is not clear how the rim can be described as having a flange and still be "flangeless." It is submitted that the rim flange shown in Applicants' figure 7 actually has a lipless flange.

Appropriate correction is required.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter.

The specification does not describe how tire changing equipment "cannot damage" the surface of the overlay or how "any form of material handling of said wheel during production and/or transportation of said assembly will prevent said cladding from becoming damaged by adjacent assemblies contacting each other" as set forth in claim 42. The claim is overly broad because the term "any form" of equipment includes such a multitude of undefined or unspecified equipment that the statement is impossible to make.

The specification does describe how certain types of equipment are prevented from contacting the overlay, or how the susceptibility to damage is reduced, but there is no disclosure for the overlay never being damaged by **any type** of equipment or handling ever as appears to be claimed.

See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 41, 52, 65, and 66 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not give any examples of the "industry standard" dimensions for the rim flange, or for the balancing weights as set forth in claims 41, 52, 65, and 66. There are many sizes and types of wheels and rims, and also many types of balance weights. It is not clear what exactly would be encompassed by the "industry standard" rim flanges and the "industry standard" balancing weights." Since there are many "standard" weights which may be used to balance a wheel, the specification is non-enabling for which weights would constitute a standard weight.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3617

10. Claims 42-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 42, the phrase "any form of material handling of said wheel during production and/or transportation of said assembly will prevent said cladding from becoming damaged by adjacent assemblies contacting each other" is not understood. It appears that Applicant is claiming that the overlay cannot ever be damaged by any equipment during production or transportation. Such equipment is not described in detail, is not shown in the drawings, and it is not seen how this limitation is possible.

Claim 52 sets forth an "industry standard" rim flange, but depends from claim 42, which purports to have a "flangeless rim flange" so it is therefore indefinite as to how the rim can have a flange and still be flangeless. Note paragraph 0060 of the instant specification which states that the so-called "flangeless rim" cannot be considered to be a standard rim.

#### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 29, 32, 33, 41, 53, 56, 57, 65, and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Beam.

The rim flange shown in figure 5 is considered to be truncated as the axial extension of the flange lip is limited. The diameter of the overlay is less than that of the wheel rim so it would be less susceptible to damage from wheel handling equipment.

With respect to claims 33 and 57, an offset is shown at 44 or 46, both of which would help locate the overlay on the wheel.

With respect to claim 41, a balance weight is shown in figure 4.

13. Claims 29, 32, 33, 34, 53, 56, 57, 58, 65, and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Chase.

Chase (U.S. Patent No. 5597213; hereafter Chase '213) discloses a wheel and overlay assembly comprising an overlay adhesively attached to the wheel and having a diameter less than that of the rim. This would inherently reduce the potential for damage caused by tire-changing equipment. As shown in figure 7, the rim has an outer lip 522 which is considered to be truncated inasmuch as it is axially shorter than some of the other flange lips shown in the patent, such as the lip 122 shown in figure 3.

The overlay may have an offset 120 as shown in figure 3.

With respect to claims 34 and 58, note that the overlay may be secured to the wheel by a foam adhesive and a silicon adhesive for sealing the assembly as described in column 9, lines 32-43.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 30, 31, 35-40, 54, 55, and 59-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beam.

With respect to claims 30, 31, 54, and 55, the tolerances between the edge of the overlay and the outermost edge of the rim flange lip would have been obvious as design expedients because those of ordinary skill in the art could readily determine suitable dimensions for the overlay to produce a desired amount of coverage, and also could determine the tolerance needed or desired to properly cover the wheel rim.

With respect to claims 35-40 and 59-64, the materials and finishes claimed are all notoriously well-known in the art and to choose any of them would have been obvious to those of ordinary skill in the art to achieve a desired property or appearance. Official Notice is hereby given with respect to claims 35-40 and 59-64.

17. Claims 30, 31, 35-40, 54, 55, and 59-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chase '213.

With respect to claims 30, 31, 54, and 55, the tolerances between the edge of the overlay and the outermost edge of the rim flange lip would have been obvious as design expedients because those of ordinary skill in the art could readily determine suitable dimensions for the overlay to produce a desired amount of coverage, and also could determine the tolerance needed or desired to properly cover the wheel rim.

With respect to claims 35-40 and 59-64, the materials and finishes claimed are all notoriously well-known in the art and to choose any of them would have been obvious to those of ordinary skill in the art to achieve a desired property or appearance. Official Notice is hereby given with respect to claims 35-40 and 59-64.

18. Claims 42-46 and 48-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgartner et al in view of Eikhoff et al.

Baumgartner et al (U.S. Patent 6068350; hereafter Baumgartner et al) discloses an overlay for a flangeless (lipless rim flange) wheel rim comprising a cover adhesively attached to the wheel as shown in figure 3. Offsets, at 51 or 58, can be used to locate the overlay on the wheel.

With respect to claims 48-51, the materials and finishes claimed are all notoriously well-known in the art and to choose any of them would have been obvious to those of ordinary skill in the art to achieve a desired property or appearance. Official Notice is hereby given with respect to claims 48-51.

The outer edge of the overlay at 58 is not described as having a diameter smaller than that of the rim flange at 41.

Eikhoff et al teaches an overlay for a wheel comprising a cover which closely fits over the wheel and may extend beyond the outer diameter of the rim (figure 10) or may have a diameter smaller than that of the rim as shown in figure 11. From this teaching it would have been obvious to size the overlay of Baumgartner et al to have a diameter that was smaller than that of the rim in order to prevent the tire from contacting the overlay during use.

With respect to claim 52, it would have been obvious for the rim to have a standard dimension in order to receive a balancing weight to so that the wheel could be balanced using conventional weights.

19. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgartner et al in view of Eikhoff et al as applied to claim 45 above, and further in view of Chase '213.

To use a foam adhesive and a bead of adhesive along the outer areas of the overlay of Baumgartner et al as modified by Eikhoff et al would have been obvious as taught by Chase '213 in order to retain the overlay with a lighter weight foam adhesive and also to seal the edges of the assembly to keep out water and other materials.

***Response to Arguments***

20. Applicant's arguments filed October 17, 2006 have been fully considered, but they are not persuasive.

Applicants' RCE filed May 15, 2007 did not contain any new arguments and therefore the arguments presented in the previous response are responded to below, and in certain paragraphs above, as appropriate.

The claims contain the same structural limitations that were previously rejected and the rejections set forth above are the same as those affirmed by the Board of Appeals in their decision of September 20, 2005.

The claims have been modified to further describe the functional language that the overlays cannot be damaged during handling of the wheels, but since the references as applied in the rejections above include all of the structural limitations they would be capable of performing all of the claimed functions.

***Conclusion***

21. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).  
Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (571) 272-6687. The examiner can normally be reached on Monday through Friday, 9 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7/23/07

  
RUSSELL D. STORMER 7/23/07  
PRIMARY EXAMINER 07